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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,497	12/20/2004	Jun Kotani	35355/47	5517

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KENYON & KENYON LLP
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SUITE 700
WASHINGTON, DC 20005

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/518,497

Applicant(s)

KOTANI ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicants' amendment to the claims filed 11/29/06 has overcome the prior art rejections made in the previous office action. The Examiner conducted an updated review of the prior art in view of these amended claims. As a result, the following new ground of rejection is being made.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1 to 6, 9 to 12, 14 to 18 and 20 to 22 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/90224 (abstract provided), as interpreted by the English language equivalent Fujita et al. '130.

Fujita et al. teach compositions that contain, in addition to a crosslinkable polyether, a crosslinkable vinyl polymer. Particular attention is drawn to column 8, line 15 and on, which begins the teaching of the vinyl polymer. As can be seen from line 59 of column 9, the vinyl polymer is, in fact, preferably a copolymer of (meth)acrylate esters. This meets the requirement of a vinyl copolymer in claim 1, as well as the limitations of claims 4 to 6. As can be seen on column 10, this polymer meets the requirement of claim 2. Note also column 11, line 53 and on, which teaches that the vinyl polymer is prepared by atom transfer radical polymerization. Column 21, line 15 and on, teaches that this vinyl polymer has terminal alkenyl groups while column 23, line 14 and on, specifically teaches forming the terminal alkenyl groups by reacting the polymer with a compound having "low polymerizability" such as 1,5-hexadiene, 1,7-octadiene or 1,9-decadiene. In this manner Fujita et al. anticipate the claimed component (A).

When such an alkenyl terminated vinyl polymer is used, patentees teach the addition of a hydrosilyl group containing polymer (column 38, line 45 and on). This meets the claimed component (B). Column 41, line 35 and on, teaches claimed component (C). Finally, column 50, line 64, teaches the addition of a metal soap as an antisagging agent. This meets claimed component (D).

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Thus while patentees do not specifically show an example having each of the essential components of claim 1, patentees do teach that each component can be present in the composition, thereby anticipating the instant claims.

On the other hand, please note Synthesis Example 1 on column 52. This prepares a vinyl copolymer (I) as claimed. To this is added a hydrosilyl group containing compound and a hydrosilylation catalyst. While these components react to form a silyl group terminated polymer, such a subsequent reaction of the components (A) to (C) is not excluded by the claims. Since Fujita et al. specifically teach the addition of metal soaps as an antisagging agent, the skilled artisan would have immediately envisioned such a compound in this composition. In this manner too, the teachings in Fujita et al. anticipate the instant claims.

Note that Synthesis Example 1 meets each of claims 9 to 12. This copolymer also meets claim 14.

The siloxanes on the bottom of column 38 meet claim 15. The calcium stearate on column 50, line 64, meets claims 16 and 17. Column 49, line 15 and on, meets claim 18.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/90224, as interpreted by the English language equivalent Fujita et al.

While column 41 teaches the ratio of (A) to (B) and the amount of component (C) required by this claim, column 50 does not specifically teach an amount of metal soap. Please note that when the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation). Thus the skilled artisan would have found an

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amount of metal soap within this claimed range to have been obvious or at least within routine experimentation and/or optimization of the teachings of Fujita et al.

6. Fujita et al. '494 is cited as being of general interest. This reference also teaches a vinyl polymer comparable to (A) and a metal soap antisagging agent but is not as close to the claims as the reference cited supra.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

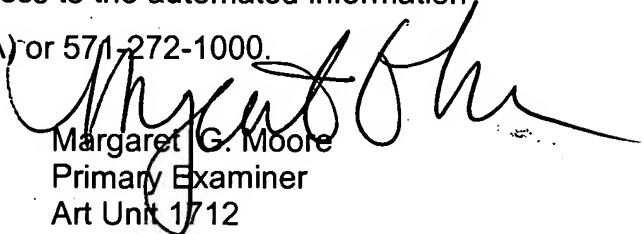
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
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mgm
2/5/07